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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,498	01/12/2001	Phillip W. Barnett	6874-105 / 10024998	2476

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M. John Carson, Esq.
FULBRIGHT & JAWORSKI L.L.P.
29th Floor
865 S. Figueroa Street
Los Angeles, CA 90017

EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,498

Applicant(s)

BARNETT ET AL.

Examiner

Fred I. Ehichioya

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 139 - 158 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 139 - 158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Claims 139 – 158 are pending in this office action.
2. Applicants cancel claims 11 – 17, 20 – 24, 37 – 43, 45 – 49, 62 – 68, and 73 – 138.
3. Applicants add new claims 139 - 158.
4. Applicants' arguments with respect to claims 139 - 158 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 139 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,974,412 issued to Brian L. Hazlehurst et al (hereinafter "Hazlehurst") in view of USPN 5,933,822 issued to Lisa Braden-Harder et al (hereinafter "Braden-Harder").

Regarding claims 139, Hazlehurst teaches a computerized tool for facilitating forward looking strategic analyses of a collection of technical documents each having a searchable text and associated bibliographic information including a source and a date, comprising the computer-assisted steps:

performing a first search to identify a subset (second collection) of documents focused on a particular field (see column 10, lines 22 – 57),

identifying those documents in the subset relevant to each of "m" "actions" (see column 2, lines 25 – 38);

identifying those documents in the subset relevant to each of "n" "objects" (see column 2, lines 48 – 56);

combining each of the "m" actions with each of the "n" objects to construct an "m" x "n" array of "cells", such that each of the cells is associated only with the documents in said subset that were identified as relevant both to the respective action and to the respective object (see column 11, lines 66 – 67 and column 12, lines 1 – 65); and

generating a graph showing each of the applied scoring metrics for each of the array cells (see column 22, lines 5 – 27).

Hazlehurst does not explicitly teach applying at least two scoring metrics to the bibliographic data for the documents associated with each of the cells, at least one of the scoring metrics including a time weighted predictive factor.

Braden-Harder teaches applying at least two scoring metrics to the bibliographic data for the documents associated with each of the cells, at least one of the scoring metrics including a time weighted predictive factor (see column 1, lines 17 – 22 and column 18, lines 8 – 24).

It would have been obvious to one of ordinary skill in the art at the time the was made to combine teaching of Braden-Harder with the teaching of Hazlehurst wherein scoring metrics to the bibliographic data for the documents associated with each of the cells is used for graphically depicting the weight, scoring, ranking and selection processes of documents. The motivation is that the scoring metrics enables the statistical search engine to rank the documents presented to the user according to the weight.

7. Claims 140 - 158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazlehurst in view of Braden-Harder and further in view of USPN 5,991,751 issued to Kevin G. Rivette et al (hereinafter "Rivette").

Regarding claims 140, Hazlehurst or Braden-Harder does not explicitly teach the actions and objects include specific instances of categories selected from the group consisting essentially of products, services, production methods, production

applications, technologies, technological applications, chemical compounds, chemical indications, inventors, assignees, forward citations to a key reference, backward citations to a key reference, and combinations thereof.

Rivette teaches the actions and objects include specific instances of categories selected from the group consisting essentially of products, services, production methods, production applications, technologies, technological applications, chemical compounds, chemical indications, inventors, assignees, forward citations to a key reference, backward citations to a key reference, and combinations thereof (see column 17, lines 55 – 67 and column 85, lines 52 – 67).

It would have been obvious to one of ordinary skill in the art at the time the was made to combine teaching of Rivette with the teaching of Hazlehurst and Braden-Harder wherein the actions and objects which include specific instances of categories are used in analyzing patents. The motivation is that patent citation identifies source patents and citing patents for reference purposes.

Regarding claim 141, Rivette teaches wherein the documents include both issued patents and not yet issued patent applications (see column 102, lines 56 – 67).

Regarding claim 142, Rivette teaches wherein the source information includes patent assignees (see column 17, lines 55 – 67).

Regarding claim 143, Rivette teaches wherein the date information includes a filing date (see column 17, lines 55 – 67).

Regarding claim 144, Rivette teaches wherein the date information also includes an issue date for the issued patents (see column 17, lines 55 – 67).

Regarding claim 145, Rivette teaches wherein one of the scoring metrics includes an innovation measure which takes into account changes of patent activity over time (see Fig. 66 and column 107, lines 24 – 48).

Regarding claim 146, Rivette teaches wherein one of the scoring metrics includes a recent innovation measure which takes into recently filed patent applications (see column 102, lines 61 – 65).

Regarding claim 147, Rivette teaches wherein one of the scoring metrics includes a measure of the relative position of a particular assignee within a particular cell (see Figs. 118 and 122).

Regarding claim 148, Rivette teaches wherein each scoring metric is focused on a different assignee (see column 11, lines 15 – 32).

Regarding claim 149, Rivette teaches wherein the graph is a spider graph showing each assignee's score for a predetermined number of key cells overlaid over the corresponding scores for at least two other assignees (see Figs. 61 – 65 and column 87, lines 47 – 63).

Regarding claim 150, Rivette teaches wherein the graph displays a visual quantitative comparison for each scoring metric (see column 94, lines 53 – 55).

Regarding claim 151, Rivette teaches wherein some of the cells are grouped into "clusters", and a combined scoring metric is displayed for each cluster (see column 54, lines 31 – 49).

Regarding claim 152, Rivette teaches wherein the bibliographic source information includes the name of a subject person, organization, or event (see column 27, lines 14 – 32).

Regarding claim 153, Rivette teaches wherein the date bibliographic information includes a publication date (see column 61, lines 32 – 43).

Regarding claim 154, Rivette teaches wherein the time weighted predictive factor is based at least in part on a publication, creation, or issue date (see column 16, lines 18 – 67 and column 17, lines 1 – 67).

Regarding claim 155, Rivette teaches wherein one of the scoring metrics includes a concentration or frequency measure which takes into account distribution of the selected documents among their respective sources (see column 30, lines 60 – 65).

Regarding claim 156, Rivette teaches wherein one of the scoring metrics includes a composite measure of dominance, innovation, and predictive innovation (Rivette discloses “dominance” as shown in Figs. 68 and 75; “innovation” as shown in column 102, lines 61 – 65 and “predictive innovation” as shown in column 1, lines 50 – 52).

Regarding claim 157, Rivette teaches wherein the actions and objects are crossed with a third dimension to form a three dimensional matrix (see column 25, lines 65 – 67; column 26, lines 1 – 5 and column 27, lines 51 – 67).

Regarding claim 158, Rivette teaches wherein the graph is a bar graph with each bar showing a particular scoring metric applied to a particular cell (see column 94, lines 60 – 65).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-303-3900.

Fred I. Ehichioya
Examiner
Art Unit 2172
January 3, 2004


SHAHID ALAM
PRIMARY EXAMINER